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AFD

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re K&N Engineering, Inc.

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Serial No. 75/385,948

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Theresa W. Middlebrook of Wagner, Middlebrook & Kimbell,  
LLP for K&N Engineering, Inc.

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114 (K. Margaret Le, Managing Attorney).

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Before Hanak, Holtzman and Drost, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 6, 1997, K&N Engineering, Inc. (applicant)  
filed an intent-to-use application to register the mark:

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for goods subsequently identified as "air filters, air cleaner assemblies and air filter assemblies for machines and vehicles" in International Class 7.<sup>1</sup> The Examining Attorney<sup>2</sup> refused to register the mark under Section 2(d) of the Trademark Act because of U.S. Registration No. 1,049,393 for the mark PHILLIPS 66 and shield design for "oil and air filters for land vehicles."<sup>3</sup>

In addition, the Examining Attorney also required a disclaimer of the wording "CUSTOM SERIES" under Section 6 of the Trademark Act.

After the Examining Attorney made the refusal and the requirement final, this appeal followed. Both applicant

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<sup>1</sup> Serial no. 75/385,948. On March 23, 1998, applicant filed an Amendment to Allege Use, which was accepted, setting forth dates of November 4, 1997, and a date of first use in commerce of November 11, 1997.

<sup>2</sup> The current Examining Attorney was not the original Examining Attorney for this application.

<sup>3</sup> Registration No. 1,049,393, dated October 5, 1976, first renewal. A copy of the registration, which more clearly shows the mark, is attached.

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and the Examining Attorney filed briefs. An oral argument was not requested.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The du Pont factors discussed in this case include the similarity of the marks, the similarity of the goods, the sophistication of the purchasers, and the channels of trade. Not all of the du Pont factors are applicable in every case. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

We start by noting that the goods in this case involve, at least to some extent, goods that are identical. Applicant seeks to register its mark for "air filters, air cleaners assemblies and air filter assemblies for machines and vehicles." The cited registration is for "oil and air filters for land vehicles." Thus, both applicant and registrant's identifications of goods include air filters for land vehicles. Applicant admits that some of the goods are the same. Appeal Brief at 3.

To determine whether the goods and services are related, we must look to the identification of goods and services in the application and registration. Dixie

Restaurants, 41 USPQ2d at 1534; Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Applicant's argument that its goods are sold in different channels of trade is not persuasive because applicant's and registrant's identifications of goods are unrestricted. We presume that the goods move through all normal channels of trade. Also, nothing in either registrant's or applicant's identification of goods would restrict it from making more expensive or less expensive air filters for vehicles. Furthermore, if the goods are sold in the same channels of trade, they would likely be encountered by the same purchasers. Nothing in the registrant's identification of goods limits the goods to those sold only in its service or gas stations. We must base our decision on the assumption that the goods identified without any restrictions move through the normal and usual channels of trade for such goods to all the usual customers for these products. Kangol Ltd. v. KangaROOS U.S.A. Inc., 23 USPQ2d 1945, 1946 (Fed. Cir. 1992); CBS Inc. Morrow, 218 USPQ 198, 199-200 (Fed. Cir. 1983).

Here, we must assume that applicant's and registrant's air filters move through the same channels of trade to the same customers. Moreover, even if we were to assume that

applicant's goods "are promoted through enthusiast magazines, and as high quality goods . . . sold at tremendously high prices" (Brief at 4), we fail to see why a potential consumer would not believe that the source of both the registrant's and applicant's goods are the same, if confusingly similar marks are used. These customers would likely believe that applicant's high priced filters are simply another line of the registrant's goods.

Despite the fact that some of the goods are identical, applicant could prevail if its mark was not confusingly similar to registrant's mark. Obviously, the marks in this case are not identical. Applicant's mark consists of the words CUSTOM and SERIES in the same script with the number 66 and a shield design in between. As shown below, registrant's mark consists of a very similar shield design with the number 66 and the word PHILLIPS.

In a particularly relevant case, the Court of Custom and Patent Appeals held that the mark CRC MARINE FORMULA 6-

66 for rust and corrosion inhibitors for boats was confusingly similar to the mark "66" for non-identical marina services and supplies. Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). The CCPA pointed out that the specimens emphasized the prominence of the "6-66" part of the mark. Id. at 36. It also found "that Phillip's mark '66' is an old and very well-known mark for petroleum products." Id. In the present case, a review of the marks shows the prominence of the shield design and the number 66. The shield design is the largest portion of both marks, and the number "66" contained in both marks is the next largest component of the mark. Visually, the "66" and shield dominates both marks. Applicant's deletion of registrant's house mark and the inclusion of the terms "custom" and "series" do not create a significantly different meaning. The words "custom" and "series" reinforce the connection with "66" by suggesting that this is another series of air filters that registrant is now producing. Also, when the marks are pronounced, the number "sixty-six" would be pronounced prominently. Thus, the commercial impressions created by the marks PHILLIPS 66 and shield design and CUSTOM 66 SERIES and shield design is similar.

Applicant argues strongly that its mark is CUSTOM 66 SERIES, not CUSTOM SERIES 66 as the Examining Attorney has referred to the mark. Applicant is not seeking registration of its mark as a typed drawing. Applicant has depicted its mark as a special form drawing. It is not clear in what order customers would verbalize its mark. It has long been a principle of trademark law that there is no correct pronunciation of a mark, In re Belgrade Shoe Co., 162 USPQ 227 (CCPA 1969), and likewise when a trademark owner displays the words and numbers in its mark differently, it cannot control in what order potential purchasers may pronounce the words in the mark. While we do not believe it affects the outcome of the case, we will refer to the mark as applicant requests.

Applicant points out that we may not dissect a mark to find confusion. Packard Press Inc. v. Hewlett-Packard Co., 56 USPQ2d 1351 (Fed. Cir. 2000). However, it is not improper to give more weight to a particular component of a mark. Id. at 1354. As explained above, the number "66" and shield design is the dominant part of both marks visually. It also dominates the commercial impression. Furthermore, the number "66" is a significant part of the mark when it is spoken.

Applicant also argues that 66 is a reference to the "famous Route 66." Brief at 3. Even if it were so (and there is no evidence in the file to that effect), there is no evidence that the term is weak when applied to air filters. Indeed, the CCPA found that the mark "66" was well-known, and it held that it was confusingly similar to a mark that included a third "6" and a hyphen as well as the wording "CRC MARINE FORMULA." Phillips Petroleum, 170 USPQ at 36. Applicant's other wording is much less distinctive than the wording in the Phillips Petroleum case. Also, the record is devoid of any evidence of third-party registrations of marks with a "66" feature.

Finally, with regard to the issue of likelihood of confusion, the words "custom" and "series" would not be as distinctive for automobile parts as the term "66" and shield design. Even if the words are not descriptive, they are much less distinctive for air filters than the "66" portion of the mark in a shield design. Their inclusion in applicant's mark would not eliminate the likelihood of confusion between the marks. Therefore, we conclude that the marks are confusingly similar.

The Examining Attorney has also made the "requirement for the disclaimer of the terms CUSTOM SERIES" final.

Office Action dated Apr. 5, 1999, p. 2.<sup>4</sup> Applicant has refused to submit the requested disclaimer.

The Examining Attorney has referred to a dictionary definition of the word "custom" defined to mean "made to order." Exhibit B. The Examining Attorney also submitted evidence that air filters, primarily heating and air-conditioning air filters, are described as custom air filters. Exhibit C. The CCPA has also held that "the word 'custom' is commonly used to indicate things made to order." In re Sun Oil Co., 165 USPQ 718, 718 (CCPA 1970) (Custom "has very little trademark significance when used in connection with blended gasoline"). The Examining Attorney has also included evidence that there are custom air filters, although most of this evidence does not relate to air filters for machines and vehicles.

Applicant asserts in its Reply Brief (p. 2) that:

[T]he goods are not, as stated by the Examiner, "a series of custom filters". As the statement of the goods provided by the Applicant in the application, and the exhibits filed by the Applicant in this file demonstrate, the goods are just plain pre-manufactured air filters, identified in a catalog, and are not "a series of custom filters."

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<sup>4</sup> The Examining Attorney explained in an earlier action that:

"The applicant again refuses to disclaim the terms CUSTOM and SERIES. The term SERIES is obviously descriptive since it only denotes that the goods [are] one of many in a series. The dispute is over the term CUSTOM."

Office Action dated Oct. 12, 1999.

A review of applicant's catalog and exhibits supports its assertion that the goods are not "a series of custom filters" as the Examining Attorney argued. Brief at 7 (referring to Exhibit B defining custom as "made to order"). There is no evidence that applicant's goods are made to order air filters, air cleaner assemblies or air filter assemblies.

The Board has long held that doubt in cases of whether a mark is merely descriptive must be resolved in favor of the applicant. In re Conductive Systems, 220 USPQ 84 (TTAB 1983). Accord In re Merrill, Lynch, Fenner, Pierce & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (Doubt regarding secondary meaning should be resolved in favor of applicant). Here, because we have some doubt as to whether the term "custom" is descriptive of applicant's goods, we resolve it in applicant's favor.

However, we have no doubt that the word "series" is descriptive of applicant's goods. The CCPA rejected the argument that MATCHBOX SERIES was not at least descriptive because it found that "merchandise in the form in which appellant puts it on the market is aptly described as a series of matchbox toys." J. Kohnstam, LTD. V. Louis Marx & Co., 126 USPQ 362, 364 (CCPA 1960). The Examining

Attorney has also included a definition of "series" as "a group of objects related by a linearly varying morphological or configurational characteristic." Appeal Brief, Ex. B.<sup>5</sup> In Saab-Scania Aktiebolag v. Sparkomatic Corp., the Board held that:

The word "SERIES" in applicant's mark is highly suggestive, if not descriptive, of a line or group of products offered by the applicant. One dictionary definition of the term is "a group of usu. three or more things . . . standing or succeeding in order and having a like relationship to each other." Thus, applicant's products which bear the "9000 SERIES" mark will be viewed as speakers in a line or series of such goods.

26 USPQ2d 1709, 1710 (TTAB 1993).

Applicant's catalog describes the custom air filter assemblies sold under the mark CUSTOM 66 SERIES and shield design as "[a]vailable in 3 different designs," which is consistent with the definition of the term "series." While mere descriptiveness was not an issue in the Saab-Scania case, it is in this case. Inasmuch as applicant is selling a series of air filter assemblies, the term "series" would be descriptive of the goods.

A term is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics

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<sup>5</sup> We can take judicial notice of dictionary definitions. Notre Dame du Lac v. J.C. Gourmet Food Imports, 213 USPQ 594, 596 (TTAB 1982), aff'd, 217 USPQ 505 (Fed. Cir. 1983)

of the goods. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 USPQ 505, 507 (CCPA 1980). A term is descriptive if it describes one of the qualities or properties of the goods. Gyulay, 3 USPQ2d at 1010. Here, applicant's goods are "air filters, air cleaner assemblies and air filter assemblies for machines and vehicles." Since they can be described as a "series" of goods, the Examining Attorney properly required a disclaimer of the term.

Applicant also argues that its mark is unitary and that no disclaimer is necessary.

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent parts.

Dena Corp. v. Belvedere International, Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Here, the terms "custom" and "series" are visually separated by the shield design with the number "66" in the middle. The mere fact that the script of the words "custom" and "series" touches the shield is not enough to demonstrate that the design is a unitary design. Instead of creating a unitary impression, the special form drawing actually separates the

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words "custom" and "series" from each other. Furthermore, applicant admits that the mark has no unitary meaning because it acknowledges that "the phrase reads 'CUSTOM 66 SERIES', which does not mean anything." Reply Brief at 3. Therefore, the mark is not unitary and a disclaimer of the word "series" is appropriate.

Decision: The refusal to register the mark under Section 2(d) is affirmed. The requirement for a disclaimer of the term "series" is also affirmed. The requirement for a disclaimer of the word "custom" is reversed. In the event that applicant appeals this decision and ultimately prevails on the Section 2(d) refusal, it will be necessary for applicant to submit a disclaimer of the term "series" apart from the mark.